TITLE

Please replace the title with "E-Mail Invoked Electronic Commerce."

REMARKS

Claims 80–93 are pending in this application, and have all been rejected under 35 U.S.C. § 103 as being unpatentable over US Pat. No. 6,246,996 to Stein et al. ("Stein.") The Applicant respectfully submits that new claims 80–93 are allowable over the cited art of record.

Stein discloses a payment system for transferring funds to a second user from the account of a first user who purchases from the second user an "information product deliverable over the Internet." Stein 2:16-20. The payment system has a front end computer and a back end computer coupled via a private network. Stein 4:23-26. The front end executes programs for interacting with users. Stein 4:59-64. The back end contains a full copy of user account information, Stein 5:55-57 and 6:8-10, and interacts with a settlement system. Stein 9:58-60. This "isolates the buyer-seller activity which occurs on the Internet from the financial and credit activity which occurs off the Internet." Stein 9:60-63.

Stein discloses that the buyer sends a message containing the buyer's account number ("cardnumber") to the seller, who then sends an inquiry to the payment system to determine if the buyer's account can be charged the value of the transaction. Stein 6:57-67 and 7: 5-10. The seller sends the information product to the user and a funds "transfer-request message" to the payment system to have the payment system transfer funds from the buyer's account to the seller's account. Stein 7:44-47. The payment system asks the buyer to authorize the transfer, Stein 7:59-62, and the buyer sends a "transfer-response" message to the payment system. Stein 8:20-23. If the buyer grants permission for the transfer, then the payment system sends a "transfer-result" message to the seller, Stein 8:46-49, and settles the transaction by transferring the funds. See Stein 9:55 et. seq.

Stein also discloses a "cardholder application" process that "occurs when an Internet user 14 wishes to establish a cardholder account 100." Stein 12:36-37.

None of the foregoing discloses or suggests the claimed invention. Stein does not disclose or suggest sending a request for registration information to a consumer computer whose user has selected a link in an received e-mail message, nor receiving registration

information that includes a consumer identification number in response. On the contrary, as described above, Stein describes a payment system that already stores consumer registration information. "In order to use the payment system 10 for transactions, the information buyer 20 and the information seller 28 both need to have subscriber or cardholder accounts with the payment system 10." Stein 5:12-15.

The mechanism disclosed by Stein for establishing such cardholder accounts is completely different than that of the claimed invention:

> The user 14 sends an application-request message 227 over the Internet 12 to the payment system 90. This request may be sent by either electronic mail or using an interactive protocol. The payment system 90 sends an application-result message 228 to the user 14. As shown in FIG. 6P, the application-result message 228 is essentially a blank form into which the user enters information for the following: the applicant's name, address, phone number, Internet e-mail address 104, and the currency preference 112, language, and preferred account identifier ID.

> The user 14 fills in parameters from the application-result message 228, and sends a newacct-request message 230 to the payment system 10. The payment system 10 sends the user 14 a newacct-result message 232. As shown in FIG. 6Q, the newacct-result message 232 contains the status 106 of the application, and if the application is approved, the cardnumber 102 assigned to the user 14.

Stein 12:41-57. Stein neither discloses or suggests that the user receives an e-mail message containing a link that, if selected by the user, will prompt a request for registration information. Rather, Stein discloses that only that user send an "application-request message 227 over the Internet 12 to the payment system" to obtain a form through which the user can provide registration information. Stein is completely silent as to the mechanism by which such an "application-request message" is prompted or generated. Indeed, according to Stein, the user can send the "application-request message" completely on its own, without any prompting at ll. Further, Stein does not disclose or suggest associating such a message with an electronic

transaction. On the contrary, Stein discloses that "A cardholder application transaction occurs when Internet user 14 wishes to establish a cardholder account 100." Stein 12:37-39. In other words, the connection request that prompts the sending of a request for registration need not be associated with a transaction at all, but can be triggered anytime the user "wishes to establish a cardholder account." Id.

The Office Action states that "the only 'arguable' limitation in independent claims describing: sending a message to a server, that server would forward said message comprising a computer address, then accessing that address." Office Action at 2. The applicants respectfully submit that this is an overly general description of the limitations of claim 80. which, inter alia, claims "sending, to a consumer computer, an electronic mail message associated with an electronic transaction, the electronic mail message including a link to a consumer information server" which, when selected, sends a request for registration information, and receives and stores the response. In other words, the applicants do not claim the general process described in above-quoted Office Action, but rather, the specific mechanism set forth in claim 80 and the rest of the pending claims. This specific mechanism is neither disclosed or suggested by Stein, and it would not have been obvious to one of ordinary skill in the art to embed such a link in an e-mail associated with an electronic transaction.

The Office Action states that "It would have been obvious to one of ordinary skill in the art to user Stein et al.'s patent because artisans already recognize that both a consumer and a merchant need to create and store registration information of a customer to distinguish one customer from another and also for future identification purposes..." Office Action at 3. The applicants respectfully point out that the present application was filed over five years ago on January 29, 1999, at a time when registration procedures for electronic commerce were not as well developed as they are today, particularly as concerns the use of both e-mail and web protocols together in electronic commerce transactions.

Further, "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Office Action provides no evidence of any suggestion to modify Stein to obtain the claimed invention has been presented.
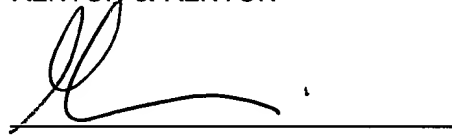
CONCLUSION

For at least the foregoing reasons, the Applicant respectfully submits that new claims 80–93 are allowable over the prior art of record. Accordingly, a Notice of Allowance is earnestly solicited.

The Commissioner is authorized to charge any additional fees which may be necessary for consideration of this Preliminary Amendment to Kenyon & Kenyon's Deposit Account No. 11-0600. A copy of this sheet is enclosed for this purpose.

Respectfully submitted,

KENYON & KENYON

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